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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,423	04/25/2001	Michael D. Jenkins	X0104E	9325

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EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,423

Applicant(s)

JENKINS ET AL.

Examiner

Ming-Hun Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,486,875 to O'Donnell in view of US Patent 6,199,292 to Ebeling and further in view of US Patent 5,856,789 to Huang.

In reference to claim 19, O'Donnell teaches a wireless pen shaped input device that includes a microphone (column 4, lines 57-61 and figure 1, item 33), a power supply (item 24), a wireless transmitter (column 4, lines 42-43) and at least one removable function module (column 3, lines 16-18). From figure 1, it is apparent that the wireless transmitter (item 27) is housed in the body of the device. O'Donnell's microphone and speaker allows communication and voice commands (column 3, lines 18-21) which inherently would include a speech processing circuit.

O'Donnell's invention is very similar to the one being claimed; however O'Donnell does not teach the dual purpose of having the antenna as the clip. Ebeling on the other hand, does teach a wireless pen device that utilizes the antenna as a clip. Ebeling writes on column 5, lines 2-5 that the "antenna is formed into a clip, as illustrated in figure 2A, which permits the pen shaped dimensioning device 30 to be attached to a shirt pocket".

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Finally, neither O'Donnell nor Ebeling teaches the idea of controlling the power supply of a computer system with the remote input device. This idea however has been well known in the art as made apparent by the Huang reference. Huang teaches a method and apparatus for switching the power supply of a computer system by a remote controller. O'Donnell's invention could have been easily modified to include Huang's idea as O'Donnell's input device already includes all the necessary technological modules necessary for wireless control of a computer system. It would have been obvious to one skilled in the art to include Huang's method into O'Donnell's invention because of convenience and power saving advantages that comes with the power supply-switching feature.

Needless to say, Huang's disclosure only teaches remote controlling and not remote controlling via voice command; However, as established in the preview office action and commonly understood by one skilled in the art, voice command is commonly used in the art as an alternate/substitute method of input.

In reference to claim 20, O'Donnell teaches that the wireless transmitter has means to communicate with the computer and the computer having a receiving means to receive audio instructions (O'Donnell: column 4, lines 58-61 and Huang: column 2, lines 65 - column 3, line 2).

In reference to claim 23, the combination of O'Donnell, Ebeling and Huang's invention is similar to the one being claimed however the references do not explicitly teach controlling the power and heat of the computer.

Huang, however, indirectly tackles the heating problem. In Huang's disclosure he outlines the advantages of his invention is save computer system power by switching off

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unnecessary peripherals and save power by placing the system in a standby mode (column 1, lines 45-50). One skilled in the art understands that by conserving power and placing the computer into standby mode, the system is in essence regulating itself from over heating.

Claim 24 is rejected on grounds presented in the rejection of claims 19 and 23.

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell in view of Ebeling in view of Huang ('789) and further in view of US patent 6,380,930 to Van Ruymbeke.

In reference to claims 2, 6 and 15, O'Donnell teaches the use of wireless data transmission, however he does not specifically single out the use of Bluetooth technology. On column 4, lines 42-44, O'Donnell states that "a wireless computer connector also is included in pen. Connector can be any acceptable technology." O'Donnell understands that RF is not the only wireless transmission alternative and leaves the particulars of the wireless transmission to those familiar to the art.

As Van Ruymbeke explains in the background of his invention, Bluetooth is a "universal wireless interface" between computer devices (column 1, lines 28-34). Naturally, one skilled in the art would utilize Bluetooth transfer communicators to assist with the portability of this pen device from system to system. As it is well known in the art, Bluetooth modules are readily available and are commonly used for wireless data transmission.

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4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell in view of Ebeling in view of Huang ('789) and further in view of US Patent 1,523,753 to Chen and US Patent 5,343,379 to Huang.

In reference to claim 22, O'Donnell's invention includes a roller ball type material that dispenses ink (see figure 1, item 13 and column2, lines 58-61).

O'Donnell's invention is missing is the incorporation of a laser pointer module. As one skilled in the art understands laser pointers on pen-like devices are extremely conventional. As demonstrated in the Huang patent ('376), this idea has been known to the art as early as 1994. One skilled in the art would have been motivated to add a laser pointer to this pen device so that users can point to objects on display screens when using the pen device to control the computer displayed contents.

O'Donnell's disclosure also does not discuss the possibility of incorporating a lead pencil function. But as one skilled in the pen art understands combinational pen/pencil writing instruments have been available for a long time now (since 1925, Chen). Adding this function to a pen device is not considered novel, as this feature allows users to switch between specific writing styles when desired.

5. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell in view of Ebeling in view of Huang ('789) and further in view of US patent 5,777,571 to Chaung.

O'Donnell on column 3, lines 19-21 teaches the use of a microphone to allow voice input commands. He however does not go into detail about the circuitry inside that allows for the voice input. The components listed in the claims 7-9 are standard if not

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inherent to the digital voice recognition/command circuit art. As one skilled in the art understands and clearly exemplified in Chaung's patent (abstract), a voice command circuit requires an A/D converter and processing unit and a buffer for proper functionality.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,616,580 to Parrott: remote power off.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu


DENNIS-DOON CHOW
PRIMARY EXAMINER